

REMARKS

Claims

Claims 1, 3-6, 10, 12, 13, 15-19, and 21-24 are currently pending and stand rejected. No amendments are proposed herein and no fees for claims are believed payable.

RESPONSE TO OFFICE ACTION DATED OCTOBER 19, 2005

I. Rejection under 35 U.S.C. 103(a) as being unpatentable over Malencon in view of Kyotaro, Maor and Flick.

Claims 1, 3, 10, 12, 13, and 15-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over FR 2242971 ("Malencon") in view of JP 08-113530 ("Kyotaro"), *International Journal of Cosmetic Science* 19, 105-110 (1997) ("Maor"), and *Cosmetic Ingredients: An Industrial Guide* ("Flick"). Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the references when combined must teach or suggest all the claim limitations. *See* MPEP § 2143.

As will be discussed in detail below, Applicants respectfully submit that no *prima facie* case of obviousness has been established because no suggestion or motivation exists to combine the reference teachings.

A. No suggestion or motivation to combine

1. The proposed combination of Malencon and Kyotaro would render both references unsuitable for their intended purposes.

It is well settled that where a proposed combination would render prior art references unsatisfactory for their intended purpose, the resulting inoperable prior art reference may be considered to teach away from the proposed combination. *See* MPEP §2143.01 V., and *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). As will be discussed in detail below, the proposed combination of Malencon with Kyotaro would render compositions of both references

unsatisfactory for their respective intended purposes. Therefore, Applicants submit that no motivation to combine these references exists.

Malencon discloses a colorless *gel* comprising filtered sea water, a gelling agent, and a germicide. (See Malencon, Example 1). Malencon is silent as to *Dead Sea* water and non-ionic solubilizer.

Kyotaro discloses bathing compositions comprising Dead Sea water or its salts. In addition, and as explained in the declaration of Shlomo Magdassi dated September 28, 2004, the bathing compositions disclosed in Kyotaro are not transparent nor are they gels. Moreover, Kyotaro also does not disclose a non-ionic solubilizer.

The proposed combination of Malencon and Kyotaro would render compositions of both references unsatisfactory for their intended purposes. Malencon states that it provides a product that has the appearance of a gel, that is practically colorless and odorless and that is applied to the skin as a pomade (page 2). The compositions are also said to be of a “certain viscosity” and easy to apply externally to the skin (page 1).

As shown in the Declaration of Shlomo Magdassi dated 28 September 2004, the Kyotaro compositions are solid, coarse, inhomogeneous powders (page 2) that are said to be designed added to bath water (See e.g. [0011]). Combining the solid, coarse, inhomogeneous bath powder of Kyotaro with the colorless gel of Malencon would render the compositions of both references unsatisfactory for their respective intended purposes. Specifically, Malencon’s clear gel compositions, upon combination with the solid, coarse, inhomogeneous powder of Kyotaro, would turn the Malencon composition into something other than a clear gel that was easy to apply externally—its stated intended purpose. It would also alter the viscosity of the Malencon gel contrary to the stated “certain viscosity” of that gel.

Moreover, combination of Malencon’s clear gel composition with Kyotaro’s solid, coarse, powder would render Kyotaro’s compositions something other than their intended solid, coarse powder suitable for addition to bath water. Kyotaro’s solid would likely turn into a sludge or slurry, but in any case something not suited for use as bath salts.

Because the combination of Kyotaro and Malencon would render each reference unsatisfactory for its respective intended purpose, these references teach away from their combination. Neither Flick nor Maor remedy this teaching away. As such, Applicant’s respectfully submit that no motivation to combine Kyotaro and Malencon exists.

2. The proposed combination of Malencon and Kyotaro would change the principle operation of both references.

It is well settled that where a proposed combination would change the principle operation of a reference, the teachings of the references are not sufficient to render the claims *prima facie* obvious. See MPEP §2143.01 VI., and *In re Ratti*, 7270 F.2d 810 (CCPA 1959). As will be discussed in detail below, the proposed combination of Malencon with Kyotaro would change the principle operation of both references. Therefore, Applicants submit that no motivation to combine these references exists.

Again, Malencon discloses a colorless *gel* comprising filtered sea water, a gelling agent, and a germicide. (See Malencon, Example 1). Malencon is silent as to *Dead Sea* water and non-ionic solubilizer. Kyotaro teaches bathing compositions comprising Dead Sea water or its salts. In addition, and as explained in the declaration of Shlomo Magdassi dated September 28, 2004, the bathing compositions disclosed in Kyotaro are not transparent nor are they gels. Kyotaro also does not disclose a non-ionic solubilizer.

The proposed combination of Malencon and Kyotaro would change the principle operation of both references. Malencon states that it provides a product that has the appearance of a gel, that is practically colorless and odorless and that is applied to the skin as a pomade (page 2). It is also to be of a certain viscosity and easy to apply externally to the skin (page 1). Combination of Malencon with the solid, coarse, inhomogeneous powder of Kyotaro would turn the Malencon composition into something other than a clear gel that is easy to apply externally. In other words, it would change the principle operation of the Malencon topical gel.

Moreover, combination of Malencon's clear gel composition with Kyotaro's solid, coarse, powder would likewise change the principle operation of Kyotaro's bath salt. Kyotaro's solid would likely turn into something along the lines of a sludge, slurry or other liquid, which clearly operates by a different principle than bath salts.

Because the proposed combination of Kyotaro and Malencon would change the principle operation of each reference, these references teach away from combination. Neither Flick nor Maor remedy this teaching away. As such, Applicant's respectfully submit that no motivation to combine Kyotaro and Malencon exists.

3. The Flick reference does not teach what the Examiner opines it teaches.

The Examiner states that “Flick teaches that nonionic, ethoxylate emulsifiers (Oleth-20) *provide* clear Carbopol gel.” (OA at page 3; emphasis added). Applicant respectfully disagrees with this characterization of Flick’s teaching. Flick does not teach that Oleth-20 can *provide* a clear gel. Flick merely teaches that Oleth-20 can be added to clear carbopol gel systems (carbopol gel systems are already clear). Flick does not, for example, teach that Oleth-20 can be used to make an otherwise cloudy gel clear, and Flick certainly does nothing to teach or suggest whether addition of Oleth-20 to a gel composition comprising Dead Sea water and hydrophobic active agent would produce a clear gel composition.

The examiner further states that “Oleth-3, another ethoxylated nonionic emulsifier produces clear gel with Crodafos phosphate esters” (OA at page 4). Flick teaches that Oleth-3 forms the primary co-emulsifier with CRODAFOS phosphate esters in clear colloidal microemulsion gels. This reference teaches only the use of Oleth-3 as a co-emulsifier with CRODAFOS phosphate esters in microemulsion gel systems. It should be pointed that this reference does not teach that a clear gel is formed due to presence of non-ionic emulsifier, but merely that this emulsifier may be added as co-emulsifier to CRODAFOS phosphate ester in colloidal microemulsion gels that are already clear. It should be pointed that CRODAFOS phosphate ester may precipitate in the presence of calcium ions in Dead sea water.

Conclusion: For at least the foregoing reasons, Applicant respectfully submits that no motivation or suggestion exists to combine the reference teachings. The proposed combination would render the references inoperable for their intended purposes, and would change the principle operation of the references. Moreover, Flick does **not** teach that Oleth-20 can *provide* a clear gel. Applicant therefore respectfully requests withdrawal of the instant rejection. Furthermore, this reference taken alone or combined does not teach or suggest that a non-ionic emulsifier *provides* a clear gel in a gel comprising an oily (hydrophobic) phase and high Dead Sea water concentrations.

II. Rejection under 35 U.S.C. § 103(a) as unpatentable over Malencon in view of Maor and Flick and further in view of U.S. 5,425,954 (“Thompson”).

Claims 4-6, 18, 19, and 21-24 stand rejected under 35 U.S.C. § 103 as unpatentable over Malencon in view of Maor and Flick, and further in view of Thompson. Applicants respectfully traverse this rejection.

As a preliminary matter, Applicants point out that if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending there from is also non-obvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) and MPEP 2143.03. Because Applicants submit that independent claim 1 is non obvious as is discussed above, Applicants also submit that claims 4 and 6 which depend on claim 1 are also not obvious.

As will be discussed in detail below, Applicants submit that no *prima facie* case of obviousness has been established because the references do not disclose each and every element of the claimed invention, and because no motivation to combine references exists.

A. The references when combined do not teach or suggest all claim limitations.

Again, to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. See e.g. MPEP § 2143.03 (“All words in a claim must be considered in judging the patentability of that claim against the prior art.” See *In re Wilson*, 424 F.2d 1382 (CCPA 1970).

Claim 5, and claims 4, 6, 18, 19 and 21-24 (by dependency on claim 1) are directed to a gel composition comprising, *inter alia*, 30% - 80% w/w of actual Dead Sea water. None of Flick, Malencon, Maor or Thompson disclose a gel composition comprising 30% - 80% w/w actual Dead Sea water. Therefore, each and every element of claims 5, and claims 4, 6, 18, 19 and 21-24 are not disclosed in any combination of the references.

B. No suggestion or motivation to combine references

Even if each and every limitation were disclosed in Malencon, Maor, Flick and Thompson, which is denied, Applicants respectfully submit that no motivation to combine the references exists; the mere fact that they can be combined, without more, is insufficient to establish a *prima facie* case of obviousness.

1. The mere fact that references can be combined is insufficient.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Applicant respectfully submits that the references do not suggest the desirability of the combination.

The Examiner states that Thompson *et al.* "...teach compositions for treatment of skin. Vitamin E/tocopherol acetate is taught as preventing the oxidation of fatty acids, thereby protecting lipids and lipoproteins in cell membrane which allows cells to retain water binding capacity and prevents dry skin." (OA at 4). The Examiner then concludes that it would be obvious to one of ordinary skill in the art at the time the invention was made "to have modified the combined references by adding tocopherol acetate as motivated by Thompson et al. because the reference teaches vitamin E protects lipids and lipoproteins in cell membranes which in turn allows cells to retain moisture and prevents dry skin."

Importantly, however, the disclosure referred to by the Examiner, presumably Col. 5, lines 60 – Col. 6 line 18 of Thompson, merely alleges various characteristics and uses of Vitamin E. Nothing in Thompson suggests a desirability of combining vitamin E with a gel comprising Dead Sea water, nor whether such a gel would be clear. The mere fact that such a combination *could* be made does not render the combination obvious without a teaching of the desirability of the combination. All Thompson discusses are attributes of Vitamin E; it provides no suggestion or motivation to combine Vitamin E with a gel comprising Dead Sea water.

Conclusion: Each and every element of the claim limitations at issue are not disclosed in any combination of Malencon, Maor, Flick and Thompson. Moreover, no teaching or suggestion exists motivating one of skill in the art at the time the instant invention was made to combine the reference teachings. Therefore, Applicants submit that no *prima facie* case of obviousness exists.

III. Conclusion

For at least the foregoing reasons, it is respectfully submitted that all claims are in condition for allowance. Early and favorable consideration is respectfully requested.

Respectfully submitted,



David B. Fournier
Reg. No. 51,696

Dated: March 16, 2006

CUSTOMER NUMBER 26565

MAYER, BROWN, ROWE & MAW LLP

P.O. Box 2828

Chicago, Illinois 60690-2828

Telephone: (312) 701-7174

Facsimile: (312) 706-9000